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EXAMINER

DUBASKY, GIGIL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/681,949	Applicant(s) FISH ET AL.	
	Examiner GIGI DUBASKY	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 12-13 and 41-42 are objected to because of the following informalities:

Claim 12 recites the limitations of “the apparatus” in line 2 and “the analog video” in line 3 which appear to be insufficient antecedent basis for these limitations in the claim.

Claim 13, line 2 recites “to produced” which appears to be a misspelling of the “to produce”.

Claims 41-42 recites as dependences on claim 32 which appears to be a mistake. They should be dependent on claim 40 instead of claim 32 based on the context of the claims. For the purpose of examination, examiner interprets claims 41 and 42 are dependent on claim 40. If there is any misunderstanding in this interpretation, Applicant is respectfully required to address clearly in the next response to this Office Action.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12-16, 21-22, 28, 38 and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Bilbrey (US 2002/0164156).

Regarding claim 12, Bilbrey discloses a system for automatically creating a digitized copy of a recorded program from a personal video recorder, the apparatus comprising: an analog-to-digital video converter for digitizing video signal; an analog-to-digital audio converter for digitizing audio signal (paragraph [0033] for input and output communications of the portable digital video player 100 are routed through a cradle 120 in Figure 8; paragraph [0050] lines 10-20 for the received analog audio visual signals are input into the encoder 126 then to be stored on storage medium 130 or transmitted to the portable digital video player 100 via multiplexers 128 and 132 in compressed form; paragraph [0026] for storing received compressed data on storage medium 102 in Figure 1. In other words, the encoder 126 must include the analog-to-digital audio visual converters or performs the same function as A/D converters for converting the received analog signals to digital signals);

a receiver for receiving a control signal (element 106 in Figure 1 and paragraph [0029] lines 1-5 for serving as an input device to receive user control signals), the control signal indicating the commencement or conclusion of playback of the recorded program from the personal video recorder (paragraph [0034] lines 10-15); and

a digital storage device for storing the digitized video signal and the digitized audio

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signal (see element 102 in Figure 1 and paragraph [0026] for storing data (video and audio) in compressed form on storage medium 102).

Regarding claims 13-16, Bilbrey discloses the system as discussed in the rejection of claim 12. Bilbrey further discloses a compression unit with an electronic circuit utilizing software that compresses the digitized video and audio signals to produce compressed digitized video and audio signals (paragraph [0009] lines 1-10 for the portable digital video player and a cradle are components of a system and the encoder of cradle is coupled to the analog audiovisual input port and produces a compressed signal. It means that the encoder of the system must include or performs the function as a compression unit to compress the digitalized signals. The portable digital video player 100 having a cradle 120 is a "laptop" or a "notebook" (paragraph [0044] lines 3-5 and paragraph [0052] lines 1-3) including a CPU programmed with a real time operating system (paragraph [0027] lines 3-6)).

Regarding claims 21-22, Bilbrey discloses the system as discussed in the rejection of claim 12. Bilbrey further discloses a storage system with removable medium for storing the digitized video signal and the digitized audio signal on a write-once and rewritable removable medium (see storage medium 102 in Figure 1 as a removable Hard Disk or the portable digital video playback device 100 in Figure 1, itself, is a transportable digital storage medium (paragraph [0057]) and storage medium 102 is also a read/write memory (paragraph [0050] lines 14-16)).

Regarding claim 28, all limitations of claim 28 are analyzed corresponding to claim 12. So, claim 28 is rejected on the same ground as claim 12.

Regarding claim 38, Bilbrey discloses the method as discussed in the rejection of claim 28. Bilbrey further discloses copying the video and audio subcomponents onto a transportable digital storage medium (see storage medium 102 in Figure 1 as a removable Hard Disk or the portable digital video playback device 100 in Figure 1, itself, is a transportable digital storage medium (paragraph [0057])).

Regarding claim 40, Bilbrey discloses a method for automated copying from a personal video recorder, the method comprising the steps of:
receiving a signal from the personal video recorder containing a recorded program (paragraph [0050] lines 8-12 for the cradle 120 in Figure 8 enables to receive compressed video data from the PVR through port 122 and analog audio visual data through port 124. The cradle is also a component of the portable digital video player system (paragraph [0009] lines 1-3)) in response to an automated copy command (paragraph [0047] for loading or copying the recorded video clips on PVR to the storage medium of the port digital video player 100 in response to user selection); and
storing the signal on a digital media (see element 102 in Figure 1 and paragraph [0026] for storing data (video and audio) in compressed form on storage medium 102).

Regarding claim 41, Bilbrey discloses the method as discussed in the rejection of claim 40. Bilbrey further discloses the signal is an analog signal, further comprising digitizing said signal (see Figure 8 and paragraph [0050] lines 12-16 for the analog audiovisual signals are input to an encoder 126 of the cradle 120 to digitalize the signals and to store them. The cradle is also a component of the portable digital video player system (paragraph [0009] lines 1-3), compressing the digitized signal and storing the compressed signal (taught by Bilbrey; paragraph [0026] for storing data in compressed form on storage medium 102).

Regarding claim 42, Bilbrey discloses the method as discussed in the rejection of claim 40. Bilbrey further discloses the signal is an encoded digital signal (paragraph [0035] for the PVR stores its compressed video files in a proprietary format (encoded and/or encrypted format); and paragraph [0050] lines 10-20 for the received analog audio visual signals are input into the encoder 126 to digitize and encode then to be stored on storage medium 130 or transmitted to the portable digital video player 100 via multiplexers 128 and 132 in compressed form), further comprising decoding said digital signal and storing the decoded signal (paragraph [0026] for the media decoder 104 in Figure 1 decodes or decrypts data prior to storing the data in compressed form on the storage medium 102).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey (US 2002/0164156) in view of the Admitted Prior Art (see Applicant's specification).

Regarding claim 1, Bilbrey discloses a method for automated copying from a personal video recorder, the method comprising the steps of:

receiving a first signal indicative of a playback (paragraph [0034] lines 10-11 and paragraph [0046]);

receiving a signal from the personal video recorder (paragraph [0050] lines 8-12 for the cradle 120 in Figure 8 enables to receive compressed video data from the PVR through port 122 and analog audio visual data through port 124. The cradle is also a component of the portable digital video player system (paragraph [0009] lines 1-3);

digitizing the signal in response to the first signal to create a digital representation of the playback (see Figure 8 and paragraph [0050] lines 12-16 for the analog audiovisual signals are input to an encoder 126 of the cradle 120 to digitalize the signals and to store them); and

storing the digital representation of the playback (paragraph [0050] lines 12-16).

Bilbrey's portable digital video player system enables to receive the analog signals to digitalize, to store and to playback. However, Bilbrey does not explicitly disclose the signal from the PVR is an analog signal.

The Admitted Prior Art system teaches the PVR has "Save to VCR" feature that will take a digitally recorded program and pass an analog copy of the program to a VCR so that the program can be recorded on a removable medium. It means that the Admitted Prior Art system discloses the received signal from the PVR is an analog signal.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey with the teaching of the Admitted Prior Art about receiving the analog signals from the PVR , so to provide a flexible system that can work compatibly with the conventional PVR system.

Regarding claim 4, Bilbrey in view of the Admitted Prior Art discloses the method as discussed in the rejection of claim 1. Bilbrey in view of the Admitted Prior Art further discloses copying the digital representation of the playback onto a digital storage medium (taught by Bilbrey; paragraph [0026] for storing data in compressed form on storage medium 102).

Regarding claim 5, Bilbrey in view of the Admitted Prior Art discloses the method as discussed in the rejection of claim 4. Bilbrey in view of the Admitted Prior Art further discloses the copying is performed on a transportable digital storage medium (taught by

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Bilbrey; see element 102 in Figure 1 as a removable Hard Disk or the portable digital video playback device 100 in Figure 1, itself, is a transportable digital storage medium (paragraph [0057])).

Regarding claim 6, Bilbrey in view of the Admitted Prior Art discloses the method as discussed in the rejection of claim 1. Bilbrey in view of the Admitted Prior Art further discloses compressing the digital representation of the playback and storing the compressed digital representation (taught by Bilbrey; paragraph [0026] for storing data in compressed form on storage medium 102).

Regarding claim 7, Bilbrey in view of the Admitted Prior Art discloses the method as discussed in the rejection of claim 1. Bilbrey in view of the Admitted Prior Art further discloses the first signal is generated by said personal video recorder (taught by the Admitted Prior Art; when a user wish to record a program previously stored on PVR, user presses a specific key or key sequence on PVR remote control to instruct the PVR to initiate the "Save to VCR" function, and the PVR sends a "Record" command to VCR).

Regarding claims 8-9, all functionalities of claims 8-9 are analyzed corresponding to claim 1. So, claims 8-9 is rejected under the same rationale as claim 1.

Regarding claim 11, all functionalities of claim 11 are analyzed corresponding to claim 6. So, claim 11 is rejected under the same rationale as claim 6.

6. Claims 2-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey (US 2002/0164156) in view of the Admitted Prior Art and further in view of Donian et al (US 2004/0003398).

Regarding claim 2, Bilbrey in view of the Admitted Prior Art discloses all the limitations of the method as discussed in the rejection of claim 1.

Bilbrey in view of the Admitted Prior Art does not explicitly disclose the transmitting the digital representation of the playback over a network.

Donian discloses the wide distribution of digital media content over a network (see Figure 1 and paragraph [0082]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey's system with the capability of transmitting digital content over a network taught by Donian, so to provide the user an enhanced system in order to exchange content with others.

Regarding claim 3, Bilbrey in view of the Admitted Prior Art and further in view of Donian discloses the method as discussed in the rejection of claim 2. Bilbrey in view of the Admitted Prior Art and further in view of Donian further discloses sharing the digital representation of the playback in a peer-to-peer network configuration (taught by Donian; paragraph [0082] and [0093]-[0094]).

Regarding claim 10, all functionalities of claim 10 are analyzed corresponding to claim 2. So, claim 10 is rejected under the same rationale as claim 2.

7. Claims 17-20 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey (US 2002/0164156) in view of Donian et al (US 2004/0003398).

Regarding claim 17, Bilbrey discloses all limitations of the system as discussed in the rejection of claim 12.

Bilbrey does not explicitly disclose a transmitter for transmitting the digitized video and audio signals.

Donian discloses any consumer-used computer devices 110, 114 or 112 in Figure 1 are capable of a temporary or ongoing digital transfer connection to any of the networked systems 104, 106, 108 and 110 (paragraph [0083]). In other words, Donian clearly teaches any consumer-used computer devices are capable of transmitting the digitized content through a network.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey's system with the capability of transmitting the digitized video and audio signals taught by Donian, so to provide the user an enhanced system in order to exchange of content with others.

Regarding claims 18-20, Bilbrey discloses all limitations of the system as discussed in the rejection of claim 12. Modifying Bilbrey's system to the teaching of Donian with the same motivation as discussed in claim 17, the combined system of Bilbrey and Donian further discloses a network interface subsystem for sharing the digitized video signal and the digitized audio signal with other computer systems on a computer network (taught by Donian; see "Network Interface 242" in Figure 2). The network interface subsystem is a client-server computer network and a peer-to-peer network (taught by Donian; paragraph [0082]).

Regarding claim 36, all limitations of claim 36 are analyzed corresponding to claim 18. So, claim 36 is rejection under the same rationale as claim 18.

Regarding claim 37, all limitations of claim 37 are analyzed corresponding to claim 20. So, claim 37 is rejection under the same rationale as claim 20.

8. Claims 23, 26-27, 29-35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey (US 2002/0164156) in view of Kimball et al (US 2004/0055012).

Regarding claim 23, Bilbrey discloses a method for automated copying of content from a personal video recorder, the method comprising the steps of: intercepting a signal from the personal video recorder (paragraph [0050] lines 8-12 for the cradle 120 in Figure 8 enables to receive compressed video data from the PVR

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through port 122 and analog audio visual data through port 124. The cradle is also a component of the portable digital video player system (paragraph [0009] lines 1-3); digitizing the video component signal and information to create a digitized version of the playback (see Figure 8 and paragraph [0050] lines 12-16 for the analog audiovisual signals are input to an encoder 126 of the cradle 120 to digitalize the signals and to store them; and paragraph [0035] lines 3-5 for embedding MPEG-2 data into video data); and storing the video component (paragraph [0050] lines 12-16) and the digitized information (paragraph [0035] lines 3-5).

Bilbrey does not explicitly disclose receiving a first signal from the personal video recorder indicative of the initiation of a playback of the content; the second signal is an analog signal containing the playback and wherein the analog signal contains a video component that contains additional information related to the playback.

Kimball discloses receiving a first signal from the personal video recorder wherein the first signal is indicative of the initiation of a playback of the content (see “user control device 107” in Figure 1 and paragraph [0033] lines 7-10 and paragraph [0039]); the second signal from PVR is an analog signal containing the playback (paragraph [0059] lines 7-9) and wherein the analog signal contains a video component that contains additional information related to the playback (paragraph [0060] lines 7-16 for the video encoder outputs an analog video signal and the content advisory rating information is inserted into the analog video signal. The content advisory rating information is also additional information related to the playback video).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey's system with the teaching of Kimball about receiving analog audio video signals containing additional information from the PVR, so to provide a flexible system that can work compatibly with the conventional PVR system and can control the content based on the inserted additional information.

Regarding claim 26, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 23. Bilbrey in view of Kimball further discloses copying the digitized video component and the digitized information onto a transportable digital storage medium (taught by Bilbrey; see element 102 in Figure 1 as a removable Hard Disk or the portable digital video playback device 100 in Figure 1, itself, is a transportable digital storage medium (paragraph [0057]); and paragraph [0035] lines 3-5 for embedding MPEG-2 data into video data).

Regarding claim 27, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 26. Bilbrey in view of Kimball further discloses the digital storage media is an optical media (taught by Kimball; paragraph [0033] lines 1-3).

Regarding claims 29-31, Bilbrey discloses all the limitations of the method as discussed in the rejection of claim 28.

Bilbrey does not explicitly disclose the first signal is generated by the personal video recorder and playback recording video component includes an imbedded data subcomponent formed of data related to the playback.

Kimball discloses the first signal is generated by the personal video recorder (see “user control device 107” in Figure 1 and paragraph [0033] lines 7-10 and paragraph [0039]) and playback recording video component includes an imbedded data subcomponent formed of data related to the playback (paragraph [0060] lines 7-16 for the video encoder outputs an analog video signal and the content advisory rating information is inserted into the analog video signal. The content advisory rating information is also additional information related to the playback video).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey’s system with the teaching of Kimball about receiving analog audio video signals containing additional information from the PVR, so to provide a flexible system that can work compatibly with the conventional PVR system and can control the content based on the inserted additional information.

Regarding to claim 32, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 31. Bilbrey in view of Kimball further discloses data component is encoded within a vertical blanking interval of said video component (taught by Kimball; paragraph [0048]).

Regarding claim 33, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 30. Bilbrey in view of Kimball further discloses digitizing said data subcomponent to define digitized data (taught by Bilbrey; paragraph [0035] lines 3-5 for embedding MPEG-2 data into video data. Also taught by Kimball; see Figure 4 for converting video, audio and VBI data by video A/D converter before input into MPEG-2 encoder).

Regarding claim 34, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 33. Bilbrey in view of Kimball further discloses comprising storing said digitized data with together with said digitized video and audio components (taught by Bilbrey; paragraph [0026] for storing data (video and audio) in compressed form on storage medium 102; and paragraph [0035] lines 3-5 for embedding MPEG-2 data into video components).

Regarding claim 35, Bilbrey in view of Kimball discloses the method as discussed in the rejection of claim 33. Bilbrey in view of Kimball further discloses data component is disposed within a blanking interval of the video component (taught by Kimball; paragraph [0048]).

Regarding claim 39, all limitations of claim 39 are analyzed corresponding to claim 27. So, claim 39 is rejected on the same ground as claim 27.

9. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey (US 2002/0164156) in view of Kimball et al (US 2004/0055012) and further in view of Donian et al (US 2004/0003398).

Regarding claim 24, Bilbrey in view of Kimball discloses all limitations of the method as discussed in the rejection of claim 23.

Bilbrey in view of Kimball does not explicitly disclose transmitting the digitized video component and the digitized information over a network.

Donian discloses the wide distribution of digital media content over a network (see Figure 1 and paragraph [0082]). The digital media content including advertising and control signals (paragraph [0057]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bilbrey's system with the capability of transmitting digital content over a network taught by Donian, so to provide the user an enhanced system in order to exchange of content with others.

Regarding claim 25, Bilbrey in view of Kimball discloses all the limitations of the method as discussed in the rejection of claim 23. Modifying the Bilbrey's system in view of Kimball to the teaching of Donian with the same motivation as discussed in the claim 24, the combined system of Bilbrey, Kimball and Donian further discloses sharing the digitized video component and the digitized information in a peer-to-peer network configuration (taught by Donian; paragraph [0082]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI DUBASKY whose telephone number is (571)270-5686. The examiner can normally be reached on Monday through Thursday from 7:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

GD